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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,158	12/11/2000	Hidehiko Ogawa	MAT-8047US	4218

7590

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EXAMINER

NALVEN, ANDREW L

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,158

Applicant(s)

OGAWA, HIDEHIKO

Examiner

Andrew L. Nalven

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 16-18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 16-18 and 20-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 16-18 and 20-21 are pending.
2. Amendment submitted 14 November 2005 has been entered.

Response to Arguments

3. Applicant's arguments filed 14 November 2005 have been considered but are moot in view of the new grounds of rejection.

4. With regards to claims 1 and 18, Applicant has argued that the cited references, Toyoda, Eguchi, and Firth, fail to teach making an extracted email address available to a recipient without opening said file (referring to attached image data). Examiner respectfully disagrees with this assertion. As previously noted, it is well known in the art to see sender information without opening an attached file. When receiving an email, a user is always able to see the sender of the email in a list of received emails. A user may open an attached email after seeing the email in the list of received emails thus the user would see the sender information before opening the attachment. However, for the purpose of expedited prosecution, Examiner has provided the Zhang reference as proof that this feature is known in the art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 16-18 and 20-21 are rejected under 35 U.S.C. 102(e) as being unpatentable over Toyoda et al US Patent No. 5,881,233 in view of Eguchi US Patent No 6,574,670, in view of Firth et al US Patent No 5,987,517, and in further view of Zhang et al US Patent No. 6,016,478.

7. With regards to claims 1 and 18, Toyoda teaches if email is designated, generating an email which includes or to which is attached inputted image data, said email including a designation that it is from said extracted name or email address (Toyoda, column 20 lines 46-53, column 21 lines 18-67, Figure 23 82A), if facsimile is designated, generating a facsimile based on said inputted image data (Toyoda, column 20 line 54 – column 21 line 6), if email is designated, transmitting the email so that the extracted name or the extracted email address is available to a recipient without opening said file (Toyoda, column 21 lines 18-67, Figure 23 82A, sender's email address is inherently available without opening attachment), and if facsimile is designated, transmitting the facsimile to the recipient (Toyoda, column 21 lines 7-18). Toyoda fails to teach the extracting of a name or an email address corresponding to an entered password or the extracting of a default name. Eguchi teaches extracting of a name or an email address corresponding to an entered password (Eguchi, column 7

line 65 – column 8 line 18, user enters code number, column 6 lines 52-64, header including sender appended when the email is sent). Firth teaches the extraction of default information or a default email address (Firth, column 17 lines 17-44). As Examiner noted above, the feature of making an email address available to a recipient without opening said file is an inherent feature of an email system because email addresses are separate from attachments and the addresses are displayed in an email inbox when an email is received. However, for the purposes of expedited prosecution Examiner is providing the Zhang reference as evidence of making an email address available to a recipient without opening (Zhang, Figure 12B, From address). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Eguchi's method of extracting names and address, Firth's method of sending default information, and Zhang's method of displaying extracted email addresses with Toyoda's facsimile apparatus because it offers the advantage of ensuring that an application program can provide all of the necessary functionality for a user by managing all details of the Internet application protocols including filling data structures and handling bad or incomplete data (Firth, column 1 line 66 – column 2 line 6), removing the need for a user to enter a long email address to identify the sender of an email (Eguchi, column 2 lines 18-34), and providing a mechanism for notifying a receiver of the sender of a message.

8. With regards to claims 16 and 20, Toyoda as modified teaches email being designated by inputting said recipients email address (Toyoda, column 21 lines 18-21).

9. With regards to claims 17 and 21, Toyoda as modified teaches facsimile designated by inputting said recipients telephone number (Toyoda, column 20 lines 54-59).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Nalven whose telephone number is 571 272

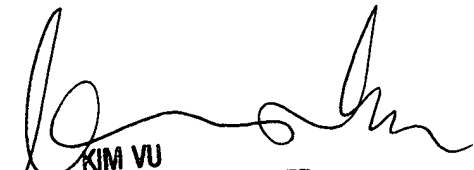

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3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571 272 3859. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



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